Remarks

No claims have been amended. Claims 1-41 are pending in this application.

Claims 1-5, 11-19, 21-28, 30-34 and 36-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Liechti et al. (U.S. Patent No. 5,715,164) in view of Williams et al. (U.S. Patent No. 4,517,410). Reconsideration is respectfully requested.

The present invention is directed to a method and system for metering messages presented to a user of a communications network, i.e., determining a number of times the message is actually presented to one or more users. For example, the message could be an advertisement in a web page displayed on a computer screen. A host web server can incorporate the advertisement in a network data stream as a message and send the network data stream to a network, such as, for example, the Internet, for viewing by a user. In accordance with one aspect of the present invention, a metering device monitors the network data to detect a code embedded in the advertisement message and counts the number of times that the advertisement is presented to the network. Thus, it is possible to accurately and securely track the distribution of the advertisement which can be utilized, for example, for billing purposes.

In view of the above, claim 1 is directed to a method of determining a number of times a message is presented to users of a communications network that comprises embedding a code in the message, detecting the embedded code, and counting the number of times, based on the detected embedded code, the message is presented to a user of the communications network.

Liechti et al., in contrast, is directed to a communication system that includes a data center that communicates with a plurality of postage meters via telephone dial-up lines to conduct resetting transactions. The data center is controlled by a postal authority, and can be used for gathering statistical data from each postage meter including the number of mail items in different postal classes processed by the postage meter. The data center can also be utilized to set postage limit amounts, time limits and piece limits on a postage meter. When the imposed limit is reached, the postage meter is programmed to halt operation. (Col. 4, line 43 to Col. 5, line 10). Liechti et al. also describes a conventional technique to reset a postage meter with additional

postage by telephone, thereby obviating the need to physically carry the postage meter to the postal authority for resetting. Specifically, the postage meter calls a computerized central facility (data center) for additional available postage. The central facility verifies the meter's identity and ascertains the availability of funds in the user's account. After the information is validated, the central facility debits the user's account and supplies a combination code to the meter or to the user for the user to introduce into the meter. The meter then independently generates another combination code and compares it with the received code. If their relationship is correct, the meter is reset with the additional postage requested. (Col. 1, lines 12-31).

The Office Action contends that the system in Liechti et al. is equivalent to the current invention. Applicant respectfully disagrees. It should first be noted that in Liechti et al., there is no disclosure, teaching or suggestion of a method or system for metering messages presented via a communication network. Liechti et al, as noted above, is directed to a communication system that includes a data center and a plurality of postage meters. A communication system in which a data center communicates with a plurality of postage meters is in no way related to a system or method for metering digital content that includes a message to be presented to users of a communication network. The Office Action contends that the actions of verifying the meter's identity, ascertaining the availability of funds in the user's account, and supplying a combination code to the meter or to the user as performed in Liechti et al. discloses embedding a code in a message. There does not appear to be any basis for this contention, as in Liechti et al. there is no disclosure, teaching or suggestion of embedding any type of code in a message. In Liechti et al., the data center communicates with the postage meters to impose limits, reset the available postage amount, or collect statistical data. This information constitutes the message itself. There is no code embedded in this information that is detected to allow for metering of the message. There is no disclosure, teaching or suggestion anywhere in Liechti et al. of embedding a code in a message or detecting the embedded code. The reference to Williams et al. does not cure the above deficiency, as it was relied upon for other features.

As noted by the Office Action, there is no disclosure, teaching or suggestion in Liechti of counting the number of times the message is presented to a user of the communications network. To overcome this deficiency, the Office Action relies on the reference to Williams et al.

Williams et al. is directed to an information retrieval system in which a plurality of messages can be stored and a user selected message can be automatically located and replayed to the user over the telephone. The system comprises a unit for storing and playing information messages, a telephone coupler unit including means for connection to a telephone line and means for detecting incoming calls on the line, an audio switching unit including means for selectively connecting the telephone coupler unit to the message storing means on detection of a call by the coupler unit, and an automatic controller associated with all of the units for controlling their operation. The controller includes means for monitoring a connected call to detect touch tone signals from a user, and means for automatically operating the information storing means in response to the touch tone signals to drive the information storing means to a user-chosen message position corresponding to the touch tone signals and to play the message stored at that position. (Col. 1, lines 36-57). The controller comprises a central processing unit comprising a microprocessor associated with a memory. The memory includes means for storing statistical information, such as the number of messages requested and the number of times each particular message is requested. (Col. 2, lines 18-29). Specifically, a counting means counts the number of times each message identifier is entered by the user indicating the number of times each messages is requested to be played back to the user. (Col. 13, lines 25-30). Thus, Williams et al. is directed to a telephone messaging system in which users can access prerecorded messages utilizing touch tone signals from a telephone and play the prerecorded message. A counter can be utilized to count the number of times a message has been played.

The Office Action contends that it would have been obvious to modify the postage meter of Liechti by including the limitation of a counter as taught by Williams because this would detect and count message data associated with each user. Applicant respectfully disagrees.

As noted above, Liechti et al. is directed to a communication system that includes a data center that communicates with a plurality of postage meters via telephone dial-up lines to conduct resetting transactions. In Liechti et al., the data center communicates with the postage meters to impose limits, reset the available postage amount, or collect statistical data. Each communication between the data center and a particular meter is a unique, one-time communication to reset the meter and intended for only a single meter. There is, therefore, no

reason or need to count the number of times it is presented to a user, as it is only provided once to a particular meter, and would not be presented to other meters. There is, therefore, no basis to the Examiner's contention that it would have been obvious to modify the postage meter of Liechti et al. by including a counter, as there is absolutely no need to make any such modification to Liechti et al. to include a counter. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If there is no need to make any such modification to Liechti, there can clearly be no suggestion of the desirability of the combination as proposed by the Examiner.

The Examiner is clearly utilizing the claims of the present invention to selectively cull elements from different references and reconstruct the present invention. The fact that the present invention was made by the Applicant does not make the present invention obvious; that suggestion or teaching must come from the prior art. See <u>C.R. Bard, Inc. v. M3 Systems, Inc.</u>, 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., <u>Uniroyal, Inc. v. Rudkin-Wiley Corp.</u>, 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so). "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and <u>to combine them in a way they were combined by the inventor</u>." <u>ATD Corp. v. Lydall, Inc.</u>, 159 F.3d 534, 545 (Fed. Cir. 1998) (emphasis added). No such proper suggestion or motivation has been provided by the Office Action. Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from these references. The rejection uses impermissible hindsight to reconstruct the present invention from these references. See Ex parte Clapp, 227 U.S.P.Q. 972,973 (Bd. App. 1985) (requiring "convincing line of reasoning" to support and obviousness determination).

Furthermore, even if one were motivated to combine Liechti and Williams as proposed by the Examiner, the resulting combination still would not disclose, teach or suggest embedding a code in the message, detecting the embedded code, and counting the number of times, based on the detected embedded code, the message is presented to a user of the communications network as is recited in claim 1. As noted above, there is no disclosure, teaching or suggestion in either Liechti or Williams or embedding a code in a message or detecting the embedded code. There can be, therefore, no counting of the number of times a message is presented to a user based on the detected embedded code. Furthermore, the counting in Williams et al. is based on the number of times a message identifier is entered by the user. The counting is not based on any type of detected embedded code as in the present invention.

For at least the above reasons, claim 1 is allowable over the prior art of record. Claims 2-11, dependent upon claim 1, are allowable along with claim 1 and on their own merits.

Each of independent claims 12 and 17 contain limitations substantially similar to those of claim 1, and for the same reasons given with respect to claim 1 are allowable over the prior art of record. Claims 14-16, 18-21, dependent upon claims 12 and 17, respectively, are allowable along with the base claim and on their own merits.

Independent claim 22 includes limitations similar to those of claim 1, and for the same reasons given above with respect to claim 1 is allowable over the prior art of record. Claim 22 includes the further limitation of calculating a charge for presenting the message based on the number of times the data representative of the embedded code is detected.

The Office Action contends that the statistical data for the number of mail items in different postal classes processed by a postage meter in Liechti discloses calculating a charge for presenting the message based on the number of times the data representative of the embedded code is detected, and relies on the disclosure of Col. 4, lines 50-60 to support this position (Office Action, page 6). Col. 4, lines 42-67, of Liechti et al. is reproduced below.

> In this illustrative embodiment, data center 15 is controlled by a postal
> authority for example. Among other things, the postal authority may be
> interested in gathering statistical data including, for example, numbers of

mail items in different postal classes (e.g. first class mail, parcel post, international mail, etc.) processed by a postage meter. Such data is not available in a prior art postage meter.

In accordance with an aspect of the invention, each postage meter is programmed to have charge classes each defined by an upper limit and a lower limit of postage values. If a class should be defined by a single value, the lower and upper limits are set to that value. For example, charge class 1 includes items with a postage value of 29 cents; charge class 2 includes items with postage values between 30 cents and 35 cents; charge class 3 includes items with postage values between 36 cents and 42 cents, and so on and so forth; any items that do not fall within one of the above charge classes are grouped within a separate, miscellaneous class 0.

Each of the above charge classes is designed to relate to a postal class. Mail items processed by the meter are tallied according to these charge classes. To this end, the meter allocates a counter for each charge class to count the items belonging to the class. The count is cumulative until the counter is read into a class reading buffer to be subsequently transferred to the data center 15.

The Office Action, on page 6, states that "charge classes i.e. class 1 and class 2 are interpreted as a process of calculating a charge." There is no basis for this interpretation. In Liechti et al., each postage meter maintains data indicating the number of mail pieces processed by the postage meter based on the charge class in which it is processed. The charge classes are defined by upper and lower limits of postage values. There is no relationship whatsoever between the tallying of mail items processed by a postage meter based on charge classes as described in Liechti et al. and calculating a charge for presenting the message based on the number of times the data representative of the embedded code is detected as is recited in claim 22. The charge classes described in Liechti et al. are for mail items that have been processed by the postage meter. The charge classes are in no way related to calculating a charge for presenting a message. There is no disclosure, teaching or suggestion in Liechti et al. of calculating a charge for presenting the message based on the number of times the data representative of the embedded code is detected as is recited in claim 22.

There is no disclosure, teaching or suggestion in Liechti et al. or Williams et al, either alone or in combination, of <u>calculating a charge for presenting the message based on the number of times the data representative of the embedded code is detected</u>. In fact, there is no need or

reason to calculate such a charge in Liechti et al. As noted above, in Liechti et al. each communication between the data center and a particular meter is a unique, one-time communication to reset the meter and intended for only a single meter. It will, therefore, only be sent once to the particular meter.

For at least the above reasons, claim 22 is allowable over the prior art of record. Claims 23-26, dependent upon claim 22, are allowable along with claim 22 and on their own merits.

Each of independent claims 27 and 38 include limitations substantially similar to those of claims 1 and 17, and also include the further limitation of calculating a charge based on the number of times the message is presented similar to that of claim 22. For the same reasons given above with respect to claims 1, 17 and 22, claims 27-41 are allowable over the prior art of record.

In view of the foregoing remarks, it is respectfully submitted that all claims are in condition for allowance and favorable action thereon is requested.

Respectfully submitted,

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